



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,431	09/07/2000	Dominique P. Bridon	REDC-2201 USA	1545
20872	7590	04/29/2005	EXAMINER	
MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482			CHISM, BILLY D	
			ART UNIT	PAPER NUMBER

1654

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/657,431

Applicant(s)

BRIDON ET AL.

Examiner

B. Dell Chism

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,10-12 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,10-12 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 19-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1654

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 January 2005 has been entered.
2. The rejections and/or objections made in the prior advisory action filed 25 January 2005 and the final office action filed 16 November 2004, which are not explicitly stated below, in original or modified form are withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Applicants' amendments in the After Final submission filed 07 January 2005 will be addressed to the extent that they pertain to the present grounds of rejection.

3. Claims 1, 3-6, 10-12 and 19-21 are pending and under consideration.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1654

5. Claims 1 and 3-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 35-36, 38 and 41 of copending Application No. 09/623,543 (filed September 5, 2000). Although the conflicting claims are not identical, they are not patentably distinct from each other because the modified antiangiogenic kringle 5 peptide identified as SEQ ID NO: 8 is the same in both applications, hence intrinsically the method of manufacture would be the same and the resulting composition would retain the same properties. Both applications teach a kringle 5 peptide-reactive group-blood protein composition. Although Applicants stated in the After Final response that Applicants had cancelled conflicting claims of the co-pending application, the examiner points out that at the same time, Applicants added new claims to the co-pending application and those claims possess similar scopes to those that were canceled. Therefore, the rejection stands with the newly added claims of the co-pending application.

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 3-6 and 10-12 and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are rejected as indefinite wherein it is unclear as to what is modified peptides and what is kringle 5 peptides and what is modified kringle 5 peptides comprising kringle 5 peptides and compositions thereof. It would appear that

Art Unit: 1654

the compositions as claimed are defined as having both “modified kringle 5 peptides” and non-modified “kringle 5 peptides”. It is not clear if all claimed peptides are modified or are only certain ones modified. The language of claims 1 and 3-6 does not match that of claims 10-12 and 19-21. One set is peptide composition comprising kringle 5 peptides (1 and 3-6), while the other set is claiming modified kringle 5 peptides comprising non-modified kringle 5 peptides. Consistent terminology would clear up the indefiniteness of what is being claimed.

Claim Objections

9. The disclosure and claims are objected to because of the following informality. All nucleotide and amino acid sequences embedded within the text of the disclosure, to include claims, must be referenced by sequence identifiers (SEQ ID NO:) (see MPEP 2422). Correction is required. See also 37 CFR 1.821, regarding sequence requirements for sequences comprising L-amino acids numbering four or greater that are post-translationally modified. Sequences appear e.g., on pages 2-3 of the specification, and in claims 19-21, but are not identified by a SEQ ID NO as required.

Conclusion

10. No claims are allowed and all claims are rejected, with objections to claims 19-21 and the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Dell Chism, whose telephone number is (571) 272-0962. The examiner can normally be reached on M-F 08:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Bruce Campell, PhD can be reached on (571) 272-0974.

Art Unit: 1654

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Dell Chism

A handwritten signature in black ink, appearing to be 'B. Dell Chism', written over a horizontal line.

PATENT EXAMINER